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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,868	07/23/2001	Theodore W. Watler	018684-001310US	4209

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EXAMINER	
LY, NGHI H	

ART UNIT	PAPER NUMBER
2617	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/911,868	WATLER ET AL.	
	Examiner	Art Unit	
	Nghi H. Ly	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *2,3,5-19,24,25,27-41,46,47,49-62,87,88 and 90-104* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *2,3,5-19,24,25,27-41,46,47,49-62,87,88 and 90-104* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/19/07 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 2, 3, 5, 6, 9-11, 13-19, 24, 25, 27, 28, 31-33, 35-41, 46, 47, 49, 50, 53-62, 87, 88, 90, 91, 94-96 and 98-104 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes (US 6,434,537) in view of Barabash et al (US 6,101,378).

Regarding claims 2, 24, 46 and 87, Grimes teaches a system for determining a charge in connection within a data communication session (see Abstract), comprising: a wireless device capable of communicating with a network (see column 1, line 58 to column 2, line 7, Grimes teaches cellular telephone, the teaching of Grimes inherently teaches "communicating with a network"), and a data rating application residing in the wireless device (see Abstract, column 3, lines 18-23 and column 6, lines 23-28), wherein the data rating application determines the charge in connection with the data communication session by multiplying a rate by a unit of measure (see Abstract, column 3, lines 18-23 and column 6, lines 23-28, Grimes teaches "calculate", in order to "calculate", the teaching of Grimes inherently teaches "multiplying a rate by a unit of measure"), and wherein the data rating application determines both the rate (see column 2, lines 1-7 and see column 2, line 67 to column 3, line 5) *and* the unit of measure by the type of data, the usage of data, the source of the data, the service level selected, the service level achieved and/**or** the connection method (see column 2, lines 1-7 and column 2, line 67 to column 3, line 5. Since the claims recite "or", the term "or" means only **one** in all, and the examiner does not select "the usage of data" to make the

rejection, and Grimes does indeed teach at least **one** of the above claimed limitation), and wherein the rate is a quantity of money per unit of measure (see Title and Abstract, Grimes teaches "billing", the teaching of Grimes inherently teaches "the rate is a quantity of money per unit of measure"), and wherein the units measure include the quality of bytes, quality of data packets and/**or** the connection involved in the communication (see column 2, line 67 to column 3, line 5, where Grimes teaches type of connection involved in the communication).

Grimes does not specifically disclose the charge is reduced from an account related to the wireless device.

Barabash teaches the charge is reduced from an account related to the wireless device (see Abstract and column 1, lines 41-59).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Barabash into the system of Grimes in order to provide prepaid cellular telephone service (see Barabash, column 1, lines 6-9).

Regarding claims 3, 25, 47 and 88, Grimes further teaches the wireless device is a mobile phone (see Abstract, "cellular telephone").

Regarding claims 5, 27, 49 and 90, Grimes further teaches the charge includes flat rate for each connection (see column 2, lines 1-7. In addition, applicant's specification fails to further define what a "flat rate" is. Therefore, Grimes does indeed teach applicant's claimed limitation with a broadest reasonable interpretation).

Regarding claims 6, 28, 50 and 91, the combination of Grimes and Barabash further teaches the data rating application is configured to deduct from prepaid account relating to the wireless device (see Barabash, Abstract and column 1, lines 41-59).

Regarding claims 9, 31, 53 and 94, Grimes further teaches the data rating application is configured to detect one of a plurality of events which takes place during the course of setting up the data communication session, wherein the event is indicative of the type of data, the usage of the data, the source of the data, the service level selected and/or the connection method wherein the origin of the event is either the network or the wireless device (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 10, 32, 54 and 95, Grimes further teaches the data rating application is configured to begin determining the charge in connection with the data communication session after detecting a begin event which takes place during the course of the data communication session (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5), and wherein the begin event is originated by either the network or the wireless device to indicate that the data communication session has begun (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 11, 33, 55 and 96, Grimes further teaches the data rating application is configured to end determining the charge in connection with the data

communication session after detecting an end event which takes place during the course of the data communication session (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5), and wherein the end event is originated by either the network or the wireless device to indicate that the data communication session has ended (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 13, 35, 56 and 98, Grimes further teaches the wireless device includes a plurality of additional applications residing therein (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5), and wherein the data rating application is configured determine the rate and unit of measure based on which one of the plurality of additional applications residing in the wireless device (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 14, 36, 57 and 99, Grimes further teaches the charge is based on usage of data received during the data communication session (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 15, 37, 58 and 100, Grimes further teaches the data received during the data communication session is a downloaded application, and wherein the charge is determined based on occurrence or duration of usage of the downloaded

application (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 16, 38, 59 and 101, Grimes further teaches the charge is based on source of data received by the wireless device during the data communication session (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 17, 39, 60 and 102, Grimes further teaches the charge is based on service level selected for the data communication session (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 18, 40, 61 and 103, Grimes further teaches the service level selected relates to speed and/or accuracy of data transmission during the data communication session (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

Regarding claims 19, 41, 62 and 104, Grimes further teaches the charge is based on service level achieved during the data communication session (see column 2, lines 1-7, see "duration or "air time" and it reads on Applicant's "the usage of data". In addition, see column 2, line 67 to column 3, line 5).

5. Claims 7, 29, 51 and 92 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes (US 6,434,537) in view of Barabash et al (US 6,101,378) and further in view of Schmid (US 5,887,249).

Regarding claims 7, 29, 51 and 92, the combination of Grimes and Barabash teaches claims 2, 24, 36 and 87. The combination of Grimes and Barabash does not specifically disclose the account resides in the wireless device.

Schmid teaches the account resides in the wireless device (see Abstract).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the Schmid into the system of Grimes and Barabash in order to provide an improved method for remotely establishing a cellular service (see Schmid, column 2, lines 13-16).

6. Claims 8, 30, 52 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes (US 6,434,537) in view of Barabash et al (US 6,101,378) and further in view of the Applicant's admitted prior art.

Regarding claims 8, 30, 52 and 93, the combination of Grimes and Barabash teaches claims 2, 24, 36 and 87. The combination of Grimes and Barabash does not specifically disclose the account balance resides at a location external to the wireless device.

The Applicant's admitted prior art teaches the account resides at a location external to the wireless device (see Applicant's background of the invention, pages 1-2).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the Applicant's admitted prior art into the system of Grimes and Barabash in order to reduce the burden on the wireless communication device.

7. Claims 12, 34 and 97 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grimes (US 6,434,537) in view of Barabash et al (US 6,101,378) and further in view of Schilling (US 7,137,548).

Regarding claims 12, 34 and 97, the combination of Grimes and Barabash teaches claims 2, 24, 36 and 87. The combination of Grimes and Barabash does not specifically disclose the data rating application resides on a smart card which is attachable to the wireless device.

Schilling teaches the data rating application resides on a smart card which is attachable to the wireless device (see column 13, lines 48-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of the Schilling into the system of Grimes and Barabash in order to provide an application of a wireless debit card to a radio telephone system (see Schilling, column 1, lines 30-33).

Response to Arguments

8. Applicant's arguments filed 06/19/07 have been fully considered but they are not persuasive.

On pages 17, 18 and 19 of applicant's remarks, applicant argues that Grimes does not teach that the rates are determined within the wireless device by the internal data rating application (see Abstract...) or Grimes does not teach any aspect of data communication rating.

In response, Grimes does indeed teach the rates are determined within the wireless device (see Abstract, column 3, lines 18-23 and column 6, lines 23-28, where Grimes teaches "calculate", in order for the wireless device to "calculate", the teaching of Grimes inherently teaches "the internal data rating application", if not, as alleged by the applicant, the wireless device of Grimes will not be able to "calculate")

On page 17 of applicant's remarks, applicant argues that Grimes does not teach any aspect of "data communication rating".

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *data communication rating*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

On page 17 of applicant's remarks, applicant further argues that Grimes does not teach the data rating application determines both the rate *and* the unit of measure by the type of data, the usage of data, the source of the data, the service level selected, the service level achieved and/**or** the connection method, *and* "the usage of data" is the

game downloaded to a wireless device, where the charge in based on each use of the game.

In response, Grimes does indeed teach the data rating application determines both the rate (see column 2, lines 1-7 and see column 2, line 67 to column 3, line 5) *and* the unit of measure by the type of data, the usage of data, the source of the data, the service level selected, the service level achieved and/**or** the connection method (see column 2, lines 1-7 and column 2, line 67 to column 3, line 5. Since the claims recite "or", the term "or" means only **one** in all, and the examiner does not select "the usage of data" to make the rejection, and Grimes does indeed teach at least **one** of the above claimed limitation).

On page 18 of applicant's remarks, applicant further argues that Grimes does not teach the charge includes flat rate for each connection.

In response, Grimes does indeed teach the charge includes flat rate for each connection (see column 2, lines 1-7. In addition, applicant's specification fails to further define what a "flat rate" is. Therefore, Grimes does indeed teach applicant's claimed limitation with a broadest reasonable interpretation).

On page 18 of applicant's remarks, applicant further argues that Grimes does not teach "setup event from the network, **or** the wireless device is indicative of the type of data the usage of the data, the source of the data, the service level selected and/**or** the connection method".

In response, Grimes does indeed teach setup event from the network, **or** the wireless device is indicative of the type of data the usage of the data, the source of the

data, the service level selected and/**or** the connection method (see column 2, lines 1-7 and see column 2, line 67 to column 3, line 5. Since the claims recite "or", the term "or" means only **one** in all, and the examiner does not select "the usage of data" to make the rejection, and Grimes does indeed teach at least **one** of the above claimed limitation).

On page 19 of applicant's remarks, applicant further argues that Grimes does not teach "the charge is based on source of data received by the wireless device during the data communication".

In response, Grimes does indeed teach the charge is based on source of data received by the wireless device during the data communication (see column 2, lines 1-7 and see column 2, line 67 to column 3, line 5).

On page 19 of applicant's remarks, applicant further argues that Barabash does not teach that rates for a communication session are determined within the wireless device by an internal data rating application or any aspect of data communication rating.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Grimes (not Barabash) teaches that rates for a communication session are determined within the wireless device by an internal data rating application or any aspect of data communication rating (see column 2, lines 1-7 and see column 2, line 67 to column 3, line 5), and the combination of Grimes and Barabash does indeed teach applicant's claimed invention.

On page 20 of applicant's remarks, applicant further argues that Schmid does not teach that rates for a communication session are determined within the wireless device by an internal data rating application or any aspect of data communication rating.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Grimes (not Schmid) teaches that rates for a communication session are determined within the wireless device by an internal data rating application or any aspect of data communication rating (see column 2, lines 1-7 and see column 2, line 67 to column 3, line 5), and the combination of Grimes and Schmid does indeed teach applicant's claimed invention.

On page 20 of applicant's remarks, applicant further argues that the Applicant's alleged admitted prior art does not teach rates for a communication session are determined within the wireless device by an internal data rating application or any aspect of data communication rating.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, Grimes (not the Applicant's alleged admitted prior art) teaches that rates for a communication session are determined within the wireless device by an

internal data rating application or any aspect of data communication rating (see column 2, lines 1-7 and see column 2, line 67 to column 3, line 5), and the combination of Grimes and the Applicant's alleged admitted prior art does indeed teach applicant's claimed invention.

On pages 20 and 21 of applicant's remarks, applicant further argues that Schilling does not teach a data rating application residing on a smart card.

In response, Schilling does indeed teach a data rating application residing on a smart card (see column 13, lines 48-61), and the combination of Grimes and Schilling does indeed teach applicant's claimed invention.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (571) 272-7911. The examiner can normally be reached on 9:30am-8:00pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on (571) 272-7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Nghi H. Ly